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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/874,314	06/06/2001	Tsuyoshi Inoue	Q64575	6107

7590 08/13/2002

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EXAMINER

ZIRKER, DANIEL R

ART UNIT PAPER NUMBER

1771

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DATE MAILED: 08/13/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

Applicant(s)

Examiner

Group Art Unit

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE -3- MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

## Status

- ☐ Responsive to communication(s) filed on \_\_\_\_\_.
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 1 1; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 1, 2 is/are pending in the application.
- Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 1, 2 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☒ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been received.
- ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.
- ☐ received in this national stage application from the International Bureau (PCT Rule 1 7.2(a)).

\*Certified copies not received: \_\_\_\_\_.

## Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 3, 4
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other \_\_\_\_\_

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1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

2. (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

3. Claims 1 and 2 are rejected under 35 U.S.C. § 102(e) as being anticipated by Shibata et al., U.S. Patent Publication No. 2001/0020515A1. Note particularly Example 4 at page 7, together with page 1 paragraph 1, page 3 paragraphs 20-22, page 4 paragraph 32, page 6 paragraphs 48, 51-52, claims 1, 4-9. The reference has an overlapping inventive entity with the present application, as well as having an earlier U.S. filing date. Note also that in Example 4 the requisite amount of a terpene-phenol resin, which clearly constitutes applicants' claimed ingredient of a copolymer of at least one aromatic compound with at least one terpene compound is clearly met.

4. (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1 and 2 are rejected under 35 U.S.C. § 102(b) as being anticipated by Matsui et al. -917. Note particularly

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Examples 8 and 10, as well as the Abstract, column 1 lines 5-10, column 3 lines 28-30, column 4 lines 14-17, column 6 lines 14-21, column 6 lines 64-67, column 7 lines 14-30). As in the previous prior art rejection, the exemplified compositions relied upon are believed to clearly anticipate the claimed rubber based pressure sensitive adhesive compound coated onto a suitable substrate.

6. Claims 1 and 2 are rejected under 35 U.S.C. § 102(b) as being anticipated by Dobashi et al. Note particularly claims 4 and 10, as well as the Abstract, column 1 lines 5-9, column 2 lines 26-53, column 3 lines 7-18, column 4 lines 1-14, column 4 line 41 - column 5 line 15, column 5 line 56 - column 6 line 45, column 8 line 61 - column 9 line 14, column 9 lines 35-50, column 10 line 66 - column 11 line 11, claims 3 and 5-9). The reference, which is believed to be an English language equivalent of JP-A-6-73352 cited on page 2 of applicants' specification, discloses a wide number of embodiments suitable for use as a protective film used to protect an automobile paint coating. The adhesive film is believed to be, in certain embodiments the same as applicants' claimed composition, and the reference further discloses in several locations (e.g. claims 4 and 10, column 9 lines 35-50) the requisite amounts <sup>of the copolymer</sup> which are required.

7. The prior art made of record and not relied upon is considered pertinent to applicants' disclosure. Note also

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JP-A-2-199184 Patent Abstract, Matsui et al. -132 and Ichimura et al.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel Zirker whose telephone number is (703) 308-0031. The examiner can normally be reached on Monday-Thursday from 8:30 A.M. to 6:00 P.M. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris, can be reached on (703) 308-2414. The fax phone number for this Group is (703) 872-9310.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661.

Dzirker:cdc

August 12, 2002

DANIEL ZIRKER  
PRIMARY EXAMINER  
GROUP 1900

1700

*Daniel Zirker*